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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,606	07/13/2001	Odile Aubrun-Sonneville	210237US0	2212

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EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 02/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,606

Applicant(s)

AUBRUN-SONNEVILLE ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-20, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the declaration filed September 27, 2001 and the priority papers. Claims 1-23 are pending.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-16 and 18-20, drawn to an emulsion and a method of making an emulsion, classified in class 524, subclass 801.
 - II. Claim 17, drawn to a method of applying a composition to the skin or lips, classified in class 514, subclass 772.4.
 - III. Claim 21, drawn to a method of using a composition to make a triple emulsion, classified in class 524, subclass 108.
 - IV. Claims 22 and 23, drawn to a make-up removing composition, classified in class 510, subclass 136.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be applied to the skin or hair or used to make a triple emulsion.

4. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be applied to the skin or lips.

5. Inventions I and IV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a cosmetic composition and for making a triple emulsion and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In

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the instant case the different inventions are unrelated because invention II does not require the composition or method steps of invention III and invention III does not require the method steps of invention II.

7. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because invention II does not require the composition of invention IV and invention IV does not require the method steps of invention II.

8. Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because invention III does not require the composition of invention IV and invention IV does not require the method steps of invention III.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I or IV, restriction for examination purposes as indicated is proper.

11. Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Group I or III, restriction for examination purposes as indicated is proper.

12. This application contains claims directed to the following patentably distinct species of the claimed invention: an emulsifier.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-6 and 11-23 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

13. During a telephone conversation with Fred Vastine on January 17, 2002 a provisional election was made with traverse to prosecute the invention of Group I and the emulsifier species of Lubrizol® 2724, a polyisobutylene with a modified succinic terminal group, claims 1-16 and 18-20. Affirmation of this election must be made by applicant in replying to this Office action. Upon further review of the specification and the prior art, the Examiner has decided to extend the search to include polyisobutylene maleic polymers and join Group IV, 22 and 23, with Group I. Claims 17 and 21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

15. The claims have been examined as far as they relate to the elected species of polyisobutylene having a modified succinic acid terminal group and its equivalents, i.e. polyisobutylene maleic acid and the anhydrides of each.

Drawings

16. The drawings are objected to because the labeling is not clear. In figure 1, it is not clear which is figure (A) and which is figure (B). The description of Figure 1(B) should be on the same page as the figure. In Figure 2, it is not clear which line corresponds to which composition. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 1-16, 18-20, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. Claims 1-8, 10-16, 18-20, 22 and 23 are vague and indefinite because the phrase "derived from" renders the claims indefinite. The specification does not provide an exclusive definition of the emulsifiers. The metes and bounds cannot be determined.

20. Claims 1, 4, 8, 10-16, 18-20, 22 and 23 are vague and indefinite because it is unclear if the polyolefinic apolar component and the polar component are part of the polyolefin, the emulsifier or the composition.

21. Claims 1-8, 16, 18-20, 22 and 23 are indefinite because it is unclear what exactly is contained in the composition. The claims are not written in a clear and concise

manner. It is unclear, for example, if the emulsifier is actually part of the composition.

Further, it is unclear if the physiologically acceptable medium is a separate component from the water and/or oily phases.

22. Claims 5-7 are indefinite because it is unclear what Applicant intends by "in character." Removal of this phrase would overcome this rejection.

Claims 6-8 are indefinite because of the term "derivative." The specification does not provide an exclusive definition of what is encompassed by the derivatives of the various substances. The metes and bounds of the claims cannot be determined.

23. Claim 6 recites a Markush group but is not written in proper Markush form. The proper language for a Markush group is, for example, "selected from the group consisting of A, B and C" or "wherein A is B or C."

24. Claim 10 is indefinite because it appears to contain the typographical error "malefic" in line 2. Applicant's intent cannot be determined.

25. Claim 11 recites the limitation "by weight of active substance" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

26. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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27. Claims 1, 4-9, 11-16, 18-20, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,708,753 (753).

US '753 is directed to water-in-oil emulsions that contain an aqueous phase containing water, an oily phase, and an emulsifier derived from at least one hydrocarbyl substituted carboxylic acid or anhydride and an amine (title and abstract). The emulsions contain about 2-70 wt.% of the oily phase, about 1-98 wt.% of the aqueous phase and about 0.05-30 wt.% of the emulsifier (col. 5, lines 38-50). For hydrocarbon oils as part of the oily phase, see column 6, line 57 to column 7, line 50. For make-up removing oils such as esters of C₁₋₁₇ alcohols with fatty acids having at least 12 carbon atoms, see column 7, lines 24-39.

The hydrocarbyl substituted carboxylic acid or anhydrides used for making the emulsifiers are made by reacting an olefinically unsaturated carboxylic acid or anhydride with a polyolefin having at least 20 carbon atoms (col. 8, line 10 to column 12, line 49). For maleic acid and anhydride, see column 8, lines 20-47. For succinic acid or anhydride, see column 10, lines 7-20. For polyisobutylene polyolefin, see column 9, lines 59-68. The example disclosed in Table 1 at column 34 contains, 54.0 wt% of an oil, 40.0 wt% water, and either 3.0 or 3.5 wt.% of the emulsifier. All of these weight percents fall within the instantly claimed weight percent ranges for each component. At column 34, lines 23-34, US '753 teaches that the emulsions are prepared by mixing the oil, water and emulsifier.

28. Claims 1-7, 9, 11-16, 18-20, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,401,341 (341).

US '341 is directed to water-in-oil emulsion compositions comprising an aqueous phase, an oily phase and an emulsifier (title, abstract, col. 3, lines 19-29 and claim 1). The aqueous phase makes up about 70-95 wt.% of the emulsion (col. 4, lines 36-39). The oil phase can be a hydrocarbon oil (col. 4, lines 45-63). For make-up removing oils such as esters of fatty acids having at least 12 carbon atoms with alcohols having 1-17 carbon atoms are disclosed at column 5, lines 34-48. The oil phase makes up about 5-30 wt.% of the emulsion (col. 6, lines 29-32). The emulsifiers are made from polyolefins with 40-500 carbon atoms (col. 6, line 64 to col. 7, line 14). Polyisobutylene succinic polymer emulsifiers and their amine salts are disclosed at column 7, lines 1-19. The emulsifiers make up about 0.5-2 wt.% of the emulsions (col. 7, lines 32-36). For combining a physiologically acceptable aqueous medium with an oily phase in the presence of a polymer emulsifier, see column 10, lines 34-62. .

29. Either one of the water or oil components of the references is a physiologically acceptable medium within the scope of the claims. The preambles directed to cosmetic or make-up removing are not given patentable weight. See *In re Tuominen*, 213 USPQ 89 and *In re Pearson*, 181 USPQ 641. There are no limitations in the claims to distinguish over the prior art. Therefore, the prior art compositions containing the same components as the instantly claimed composition can be used as cosmetics and make-up removing compositions.

30. The limitation directed to reducing the interfacial tension between the aqueous phase and the oily phase 4 is inherent and not given patentable weight. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the

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identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product.

Claim Rejections - 35 USC § 103

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

33. Claims 1-16, 18-20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US 4,708,753 (753) or US 5,401,341 (341) each in combination with the other.

US '753 discloses all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not explicitly teach that the polyolefinic apolar component of the emulsifier comprises from 60-700 carbon atoms.

US '341 discloses all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not teach that the emulsifier is prepared by the reaction of a polyolefin derivative with at least one acid from claim 8 or the reaction product of maleic anhydride with polyisobutylene.

Both references are directed to water-in-oil emulsions that contain the same components and may be used for the same purpose. US '341 teaches at column 6, lines 64-68 that the polyolefin contains from 40-500 carbon atoms. US '753 teaches the reaction product of maleic anhydride and polyisobutylene.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the emulsion of either US '753 or US '341 using the emulsifiers of either reference for their emulsifying properties.

Correspondence

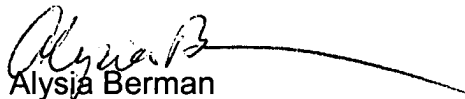
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

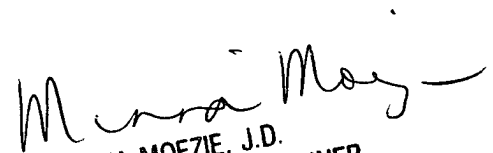
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
February 21, 2002


MINNA MOEZIE, J.D.
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